REMARKS

Claims 1-30 are pending in the application.

Claims 1-30 have been rejected.

Rejection of Claims under 35 U.S.C. § 103

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by U.S. Patent No. 6,570,875, issued to Hegde ("Hegde") in view of one or more other references, as discussed below. Applicants respectfully traverse these rejections.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. See 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. See MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998). The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. See MPEP 706.02(j).

Independent Claims 1, 9, 16, and 23.

Independent Claims 1, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hegde in view of U.S. Patent No. 5,539,659 issued to McKee ("McKee"). Independent Claim 23 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hegde in view of McKee, as well as in view of U. S. Patent No. 6,463,067 issued to Hebb *et al.* ("Hebb"). Applicants respectfully traverse these rejections.

In response to the previous Office Action in this matter dated July 23, 2004, Applicants responded to this rejection by presenting discussion related to, *inter alia*, the lack of teaching, suggestion or motivation to combine the Hegde and McKee references and the lack of expectation of success of such a combination. *See* Response to Non-Final Office Action (August 31, 2004), pp. 13-14. In response to such discussion, the present Office Action states the following:

> The applicant argued that, "... there is no teaching, suggestion, or motivation to combine the reference either in Hegde or McKee or in the knowledge of the art ... Hegde discloses a router ... every packet ... continually monitoring of incoming packets ... switch engine ..." in page 13, 2nd paragraph; page 14, 2nd paragraph, and page 12, 3rd paragraph.
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> In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a router...every packet...continually monitoring of incoming packets...switch engine) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Office Action (Dec. 20, 2004), pp. 18-19. In light of these statements in the present Office Action, Applicants believe that the prior response has been misinterpreted and that the discussion bears further explanation and reconsideration by the Examiner.

As stated above, the referenced discussion relates to whether it is appropriate to combine the Hegde and McKee references. Such discussion can focus on whether "the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, [if so] then there is no suggestion or motivation to make the proposed modification." MPEP 2143.01. The discussion can also focus on whether there is a reasonable expectation of success in combining the references. MPEP 2143.02 ("The prior art can be modified or combined to reject claims as *prima facie* obvious so long as there is a reasonable expectation of success."). In performing analyses pertinent to such discussion, the focus is on the teaching of

the references themselves, not the rejected claims. Therefore, in discussing the lack of combinability of Hegde with McKee, it is appropriate to focus on what Hegde and McKee disclose (*e.g.*, a router that continually monitors each packet).

In the light of this explanation, Applicants reiterate the previous discussion related to the lack of combinability of the Hegde and McKee references. Hegde discloses a router that is designed to update its routing tables upon a determination that a source or destination of a packet is not present in a flow table. In order to do this, Hegde must monitor every packet of information coming through the disclosed ports. *See* Hegde 5:38-43 ([S]witch module 60 continually monitors each of the ports for incoming traffic when a data packet arrives, it checks the packet header for information that identifies the flow to which the packet belongs.")(emphasis added); 8:18-23 ("The switch then enters into an operational state wherein switch engine 100 continually monitors for data packets arriving on each of ports 50 via port interfaces 120-1...120-N (step S6). When a packet is received (step S8), it is processed in accordance with the algorithm further illustrated in Figure 7 (step S10).")(emphasis added). Therefore, in order to function properly, Hegde must monitor every packet in order to determine whether or not a flow table entry must be added. The Hegde router cannot operate in a mode where not every packet is analyzed. Hegde processes a packet not based upon a sampling algorithm, but on whether a source/destination address combination is found in the flow table. If Hegde did not analyze at least the source and destination of each received packet, the Hegde router could not effectively update its flow tables. Thus, a person of ordinary skill in the art would not be motivated to combine Hegde's continuously monitoring router with McKee's random sampling because it would render the Hegde router unsuitable for its intended purpose. MPEP 2143.01.

Further, because Hegde requires continuous monitoring of each incoming packet as discussed above, a person of ordinary skill in the art would not expect success to be achieved by combining Hegde with McKee's random sampling. As stated above, if Hegde did not analyze at least the source and destination of each received packet, then the Hegde router could not effectively update its flow tables. Therefore, a person of ordinary skill in the art would not expect McKee's random sample of packets to provide the information that a Hegde router requires to succeed. MPEP 2143.02.

In addition, Applicants respectfully submit that the Examiner has not satisfied the burden of factually supporting the alleged motivation to combine Hegde and McKee. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must provide evidence to suggest the combination and "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). McKee discloses a system wherein a plurality of network monitoring devices connected on various segments of a network are operative to randomly examine packets on sub-networks to which each monitoring device is connected and then transmit data to a processing station. *See* McKee 3:3-6; McKee Fig.1 (labels 12, 13). In order for McKee to properly assess network activity, the processing station must be able to gather data across the network from the various monitoring devices. McKee 3:10-14. McKee's own teaching therefore runs counter to a combination such as that suggested by the Examiner wherein such a combination could not satisfy the distributed requirements of McKee. Further, as indicated above, Hegde could not function if only a sampling of packet data were analyzed. Therefore, Hegde's teaching runs counter to the suggested combination. Since such

combinations would render the references unsuitable for their intended purposes, it cannot be said that there is any suggestion or motivation to combine from the references themselves.

Applicants further respectfully submit that even should the Hegde router be combined with McKee, the combination would not teach each claimed limitation of Claims 1, 9, 16 and 23. As stated above, a device as disclosed in Hegde must monitor every packet of information coming through the disclosed ports. *See* Hegde 5:38-43; 8:18-23. Even with the random sampling proposed by McKee, a device embodying the combination of Hegde with McKee must continue to monitor each packet in order for the device to properly function. The present claims provide a method / apparatus / network node that determines whether to process a group of information according to a sample algorithm and then only processes the group of information if the determination is to so process the information. A Hegde / McKee combination cannot provide such functionality.

For at least the above reasons, Applicants respectfully submit that the stated combination of Hegde with McKee (Claims 1, 9, 16) and Hegde with McKee and Hebb (Claim 23) do not present a *prima facie* case of obviousness for the independent claims, and all claims dependent upon them, and that therefore all these claims are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration of the rejections to those claims.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on February 22, 2005.

Attorney for Applicant(s) — Date of Signature: 2/22/2005

Respectfully submitted,

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